

REMARKS

In the Official Action, the Examiner rejected claims 1, 2, 4-10, and 12-26. Further, the Examiner objected to claims 11 and 27. Reconsideration of the application is respectfully requested.

Allowable Subject Matter

The Examiner objected to claims 11 and 27 as being dependent upon a rejected base claim, but would allow the claims if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for indicating that the subject matter recited in dependent claims 11 and 27 is allowable. As discussed below, claim independent claim 26 has been amended to include the subject matter previously recited in dependent claim 27. Applicants respectfully submit that claim 26 is currently in condition for allowance. Claim 1 had not been amended to include the subject matter of claim 11. While Applicants agree with the Examiner that the subject matter recited in claim 11 is indeed allowable, Applicants also assert that independent claim 1, from which claim 11 depends, is currently allowable for the reasons set forth below.

Rejections under 35 U.S.C. § 102

The Examiner rejected claim 26 under 35 U.S.C. § 102(e) as being anticipated by Shih et al. (U.S. Pat. No. 6,405,362). Specifically, with regard to the independent claim, the Examiner stated:

Shih teaches a method of removing an option pack of a main unit, the method comprising:

de-activating one or more signals configured to detect the presence of the option pack in the main unit [card has been removed, column 7, lines 23-25 and 62-64];

disabling control buffers [free resources used by application, column 7, lines 25-29 and 62-67];

terminating functionality of the one or more applications running on the main unit [terminates the application, column 7, lines 62-64]; and

removing the one or more applications and associated drivers from the main unit [column 7, lines 25-30 and 64-67].

Applicants respectfully traverse this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

Claim 26 has been amended to include the subject matter previously recited in claim 27. Specifically, act (d) of claim 26 has been amended to recite “uploading the one or more applications and associated drivers from the main unit to the option pack.” As indicated by the Examiner, this limitation is not disclosed in the Shih reference, or any of the art of record. Accordingly, Applicants respectfully submit that claim 26 is currently in condition for allowance. Thus, Applicants respectfully request withdrawal of the Examiner’s rejection and allowance of claim 26.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 4-10 and 12-25 under 35 U.S.C. § 103(a) as being unpatentable over Shih et al. (U.S. Pat. No. 6,405,362) in view of Mills et al. (U.S. Pat. No. 6,353,870). Applicants respectfully traverse these rejections. Specifically, with regard to the independent claims, the Examiner stated:

Regarding claim 1, Shih teaches a method comprising:

coupling an option pack [Compact Flash, PCMCIA memory card or other removable computer readable medium] to a main unit [Palm-size PC, column 6, lines 43-46],

the option pack comprising a first memory device configured to store one or more applications and drivers associated with the one or more applications [column 6, lines 9-20],

the main unit comprising a device manager [operating system, column 6, lines 20-25], a power supply and a third memory [column 4, lines 49-51 and Figure 1]; and

downloading the one or more applications and associated drivers from the first memory device to the third memory device [column 7, lines 20-23 and lines 55-61].

Shih does not explicitly specifically disclose a second memory device on the option pack that stores card identification data and is different from the first memory device. Shih does state that the option pack may be any well known removable computer medium [column 6, lines 43-46]. Mills discloses a known MultiMediaCard, which includes a first memory for storing application data [Memory Core in Figure 3A] and a second memory, which is different from the first memory, that stores card identification data [CID and CSD in Figures 3A and 3B]. Mills discloses that the CID and CSD registers contain information that is needed for the card to interface with host computers [Figure 3B].

It would have been obvious to one of ordinary skill in the art to use the Mills MultiMediaCard as the removable computer medium disclosed by Shih as it is a known removable computer medium capable of fulfilling Shih's goal of providing additional functionality to a palm-size PC.

Regarding claim 20, Shih teaches a method of connecting an option pack to a main unit comprising:

powering on the main unit and determining if there is an option pack coupled to the main unit [column 6, lines 41-51 and column 8, lines 10-18];

providing an interrupt signal from the option pack to the main unit, interrupting the processing of the main unit and notifying the main unit that the option pack is present [column 6, lines 32-40 and 42-46]; and

downloading one or more software applications and associated drivers from the option pack to the main unit [column 7, lines 20-23 and 55-61].

Shih does not explicitly specifically disclose a second memory device on the option pack that stores card identification data and is different from the first memory device. Shih does state that the option pack may be any well known removable computer medium [column 6, lines 43-46]. Mills discloses a known MultiMediaCard, which includes a first memory for storing application data [Memory Core in Figure 3A] and a second memory, which is different from the first memory, that stores card identification data [CID and CSD in Figures 3A and 3B]. Mills discloses that the CID and CSD registers contain information that is needed for the card to interface with host computers [Figure 3B].

It would have been obvious to one of ordinary skill in the art to use the Mills MultiMediaCard as the removable computer medium disclosed by Shih as it is a known removable computer medium capable of fulfilling Shih's goal of providing additional functionality to a palm-size PC.

Applicants respectfully traverse these rejections. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Claim 1 recites an option pack comprising “a first memory device configured to store one or more applications and drivers associated with the one or more applications, and a second memory

device configured to store identification data.” Claim 1 further recites “wherein the first memory device is different from the second memory device.” Accordingly, the recited option pack includes a first memory device *and* a second memory device, each configured to store different types of information. Similarly, claim 20 recites “transmitting identification information from a first memory device on the option pack to the main unit,” and “downloading one or more software applications and associated drivers from a second memory device on the option pack to the main unit, wherein the first memory device is different from the second memory device.”

As acknowledged by the Examiner, the Shih reference does not disclose a second memory device on the option pack that stores car identification data and is different from the first memory device. Office Action, Page 4, lines 3-4. The Examiner cited the Mills reference as disclosing these additional features. Specifically, the Examiner cited Figs. 3A and 3B as disclosing those features which are clearly missing from the Shih reference. However, Applicants respectfully traverse the Examiner’s assertion and submit that Figs. 3A and 3B do not disclose independent memory devices, one for storing identification information and one for storing data.

As explicitly stated in the Mills reference, “Figs. 3A and 3B represent the prior art internal architecture of a generic MultiMediaCard and its registers.” Col. 2, lines 3-5. Fig. 3A is a functional block diagram of the MultiMediaCard which illustrates a number of logical components, such as a memory core, memory core interface, card interface controller and a number of registers. Fig. 3B provides a legend describing the registers illustrated in Fig. 3A. The Examiner correlates the “memory core” of Fig. 3A with the recited “first memory device,” and correlates the registers CID and CSD with the recited “second memory device.” However, Applicants respectfully point out that there is absolutely no discussion of either Fig. 3A or Fig. 3B in the specification of the Mills reference, other than the sentence quoted above. Applicants further assert that there is no indication whatsoever that

the various functional components of the MultiMediaCard architecture illustrated in the architectural depiction of Fig. 3A are independent memory devices. Without any further discussion present in the Mills reference, Applicants assert that those skilled in the art would not view the memory core and the registers illustrated in Fig. 3A as “a first memory device” and a “second memory device.” Rather, those skilled in the art would understand that Fig. 3A simply provides a logical, functional depiction of the MultiMediaCard. There is no disclosure or suggestion that the memory core and the registers disclosed in the Mills reference are separate memory devices. Accordingly, Applicants respectfully submit that the Mills reference fails to cure the deficiencies of the Shih reference, previously acknowledged by the Examiner.

Because the cited art, taken alone or in combination, fails to disclose all of the elements recited in independent claims 1 and 20, the cited combination cannot possibly render the claims obvious. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejections and allowance of independent claims 1 and 20, as well as those claims dependent thereon.

Official Notice

As discussed above, it is clear that neither the Shih reference nor the Mills reference disclose a first memory device and a second memory device as recited in independent claims 1 and 20. In addition, it is also clear that neither of the references disclose “determining whether the power supply in the main unit has enough power to activate the option pack fully,” or “determining whether the third memory device on the main unit has enough memory capacity to receive the applications and associated drivers stored on the first memory device of the option pack.” The Examiner takes Official Notice that such features are well known in the art. In accordance with M.P.E.P. § 2144.03, Applicants seasonably traverse and challenge the Examiner’s use of Official Notice. Specifically, Applicants respectfully request objective evidence, such as an additional reference, in support of

the Examiner's position if the rejection is to be maintained. If the Examiner finds an additional reference and applies it in combination with the presently cited references, Applicants further request that the Examiner specifically identify the portions of the newly cited reference that discloses the allegedly "well known" elements of the recited claim, or withdraw the rejection.

With specific regard to claims 16, 18, 22 and 23, the claims generally recite subject matter relating to determining whether the power supply in the main unit has enough power to activate the option pack before downloading the one or more applications and associated drivers. For example, claim 16 recites, "determining whether the power supply in the main unit has enough power to activate the option pack fully." Claim 18 recites, wherein the downloading, "occurs after the device manager has determined that there is enough power in the power supply of the main unit to activate the option pack fully."

With specific regard to claims 17, 19, 24 and 25, the claims generally recite subject matter relating to determining whether a third memory device in the main unit has enough memory to receive applications and associated drivers from the option pack before downloading the one or more applications and associated drivers. For example, claim 17 recites, "determining whether the third memory device on the main unit has enough memory capacity to receive the applications and associated drivers store on the first memory device of the option pack." Claim 19 recites, wherein the downloading, "occurs after the device manager has determined that the third memory device on the main unit has enough memory capacity to receive the applications and associated drivers."

As discussed in the present specification "the main unit 10 will verify whether it has enough power and memory to accommodate the option pack 12." Page 23, lines 7-8. "This provides a safeguard against over-loading or draining the resources on the main unit 10." Page 23, lines 8-9.

Contrary to the Examiner's assertions, Applicants submit that it is not notoriously well-known in the art that a power supply check be implemented after an option pack is inserted into a main unit of the PDA, but before any applications or drivers are downloaded. Further, Applicants submit that it is not notoriously well-known in the art that a memory capacity check be implemented after an option pack is inserted into a main unit of the PDA, but before any applications or drivers are downloaded.

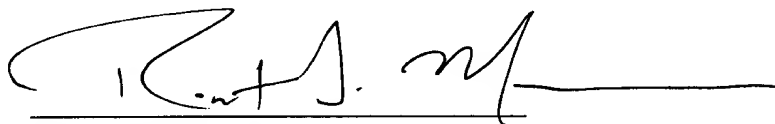
Notwithstanding Applicants position that these claims are allowable based on their dependency on allowable base claims, Applicants respectfully submit that claims 16-19 and 22-25 are also allowable based on these additional reasons. If the Examiner chooses to maintain these rejections, Applicants respectfully request objective evidence in support of this position.

Conclusion

In view of the remarks set forth above, Applicants respectfully request allowance of claims 1, 2 and 4-26. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone listed below.

Respectfully submitted,

Date: January 4, 2005

A handwritten signature in black ink, appearing to read 'Robert A. Manware', written over a horizontal line.

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